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09/835,481	04/17/2001	Linda Marie Hartman	10633/13	8060

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EXAMINER
AMINI, JAVID A

ART UNIT	PAPER NUMBER
2672	6

DATE MAILED: 06/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.		**Applicant(s)**
	09/835,481		HARTMAN, LINDA MARIE
Office Action Summary	**Examiner**		**Art Unit**
	Javid A Amini		2672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Response to Amendment

The response to office action filed on March 04, 2003 under 37 CFR 1.131 has been

considered.

Amendment to the claims:

<u>List of claims:</u>

Claim 5. (New Claim): A method for developing a request for proposal and a responding proposal, comprising: generating at a first device a first overlay representing the request for proposal, the first overlay including references to a first database for text segments associated with selected elements; sending the first overlay to a second device; and receiving at the first device a second overlay from the second device, the second overlay representing the responding proposal to the request for proposal, the second overlay comprising a modified version of the first overlay.

Claim 6. (New Claim): The method of claim 5, further comprising: retrieving from the first database a first set of data corresponding to the first overlay and a second set of data corresponding to the second overlay; and displaying the responding proposal based on the first and second sets of data.

Claim 7. (New Claim): The method of claim 5, wherein the generating the first overlay comprises: receiving a selection for at least a first element from a first set of elements; receiving at least one performance/prescriptive value for the first element; and storing a first representation for the first element and the corresponding performance/prescriptive value in electronic form.

Claim 8. (New Claim): The method of claim 7, wherein the generating the first overlay further comprises: receiving a document function indication of request for proposal; and associating text segment references with text segments that use the imperative mood appropriate for the request for proposal.

Claim 9. (New Claim): The method of claim 7, further comprising: receiving the first overlay at the second device; generating the second overlay using the first overlay; and sending the second overlay to the first device.

Claim 10. (New Claim): The method of claim 9, wherein the generating the second overlay comprises: retrieving from a database the first element and the corresponding performance/prescriptive value based on the first overlay; receiving a selection for at least one second element from a second set of elements, the second element comprising a subset of the first element and in accordance with the first element's performance/prescriptive value; and storing a second representation for said second element with the first representation in electronic form.

Claim 11. (New Claim): The method of claim 10, wherein the database is the first database.

Claim 12. (New Claim): The method of claim 10, wherein the database is a second database.

Claim 13. (New Claim): The method of claim 10, wherein the generating the second overlay further comprises: receiving a document function indication of proposal; and associating text segment references with text segments that use the indicative mood appropriate for the responding proposal.

Claim 14. (New Claim): A method for developing a request for proposal and a responding proposal, comprising: generating at a first device a first overlay representing the request for proposal, the first overlay including references to a database for text segments associated with selected elements, the generating including receiving an indication of document function; and associating the appropriate grammatical mood with at least one referenced text segment based on the indicated document function; sending the first overlay to a second device; and receiving at the first device a second overlay from the second device, the second overlay representing the responding proposal to the request for proposal, the second overlay comprising a modified version of the first overlay.

Claim15. (New Claim): The method of claim 14, wherein the generating the first overlay comprises: receiving the document function indication of request for proposal by an owner to a design-builder; and G associating text segment references with text segments that use the imperative mood appropriate for the request for proposal by an owner to a design-builder.

Claim 16. (New Claim): The method of claim 15, wherein the text segment references are associated with text segments prefaced with language similar in mood and style to the phrase "Design and select materials to provide...".

Claim 17. (New Claim): The method of claim 14, wherein the generating the first overlay comprises: receiving the document function indication of request for proposal by a design-builder to a sub-contractor; and associating text segment references with text segments that use the imperative mood appropriate for the request for proposal by a design-builder to a sub-contractor.

Claim 18. (New Claim): The method of claim 17, wherein the text segment references are associated with text segments prefaced with language similar in mood and style to the phrase "Provide...".

Claim 19. (New Claim): The method of claim 14, further comprising: receiving the first overlay at the second device; generating the second overlay using the first overlay, the generating including receiving an indication of document function; and associating the appropriate grammatical mood with at least one referenced text segment based on the indicated document function; and sending the second overlay to the first device.

Claim 20. (New Claim) The method of claim 19, wherein the generating the second overlay comprises: receiving a document function indication of proposal; and associating text segment references with text segments that use the indicative mood appropriate for the responding proposal.

Claim 21. (New Claim):p The method of claim 20, wherein the proposal is by a design-builder to an owner.

Claim 22. (New Claim): The method of claim 20, wherein the proposal is by a sub-contractor to a design-builder.

Claim 23. (New Claim): The method of claim 20, wherein the text segment references are associated with text segments prefaced with language similar in mood and style to the phrase "Construction will provide...".

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 rejected under the judicially created doctrine of obviousness-type double patenting

as being unpatentable over claim 18 of U.S. Patent No. 6236409 B1 in view of Pelletier. In

claim 1, last paragraph of application discloses, "using a document-use global switch option".

Examiner assumes "global switch" means: converts units, formats, fonts, and different

languages. And Pelletier discloses in (col. 8, lines 15-19), an international set of guidelines that

knows to convert to the appropriate units of measurement--where it says "1 inch" in the U.S.

version it would say "2.54 cm" in the European version, therefore, the step is obvious if this

option added to the claim 18 of U.S. Patent No. 6236409 B1.

Claim Rejections - 35 USC § 112

Claims 1-4 Claim under 35 U.S.C. 112, first paragraph, as failing to comply with the

enablement requirement. The claim(s) contains subject matter, which was not described in the

specification in such a way as to enable one skilled in the art to which it pertains, or with which

it is most nearly connected, to make and/or use the invention. Regarding claims 1-4, the

terminology of phrase " using a document-use global switch option" is not enabled by the

specification, because the specification only specifies "global switch option" instead of "using a

document-use global switch option".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 5, 7-18, 20-21 and 23 rejected under 35 U.S.C. 103(a) as being unpatentable over

Johnson.

1.   Claim 5.

"A method for developing a request for proposal and a responding proposal, comprising:

generating at a first device a first overlay representing the request for proposal, the first overlay

including references to a first database for text segments associated with selected elements;

sending the first overlay to a second device; and receiving at the first device a second overlay

from the second device, the second overlay representing the responding proposal to the request

for proposal, the second overlay comprising a modified version of the first overlay", examiner

assumes that a request for proposal (RFP) is a proposal for bids that indicates the specifications

for a particular task or other system needs (another words may be selling services or products).

Johnson teaches in Fig. 10 a block diagram a detailed depiction of the elements in a preferred

report generator, this part can be assumed as a first overlay. Johnson teaches in Fig. 11 a block

diagram showing a detailed depiction of the elements in a preferred selection device, meaning

this is the next device (second device) that provides more detailed information to first overlay,

and can be called second overlay. And also second overlay is the modified version of first

overlay. Johnson illustrates in Figs. 17-42 the connectivity of a user, databases, and devices.

Johnson does not disclose expressly the "request for proposal", but teaches the "proposal";

however, it would have been obvious at the time the invention was made to a person of ordinary

skill in the art to customized, high-quality proposals which has many potential applications, and

will have a great appeal to each individual customer and will be an asset in selling the product.

2.   Claim 7.

" The method of claim 5, wherein the generating the first overlay comprises: receiving a

selection for at least a first element from a first set of elements; receiving at least one

performance/prescriptive value for the first element; and storing a first representation for the first

element and the corresponding performance/prescriptive value in electronic form", Johnson

illustrates in Fig. 1A, that shows conceptually a database that electronically stores a plurality of

pictures. The pictures may include environment pictures, product pictures, and pictures for various parts. A textual descriptions database may store a plurality of text segments that correspond to various pictures in the picture database.

3.   Claim 8.

"The method of claim 7, wherein the generating the first overlay further comprises: receiving a document function indication of request for proposal; and associating text segment references with text segments that use the imperative mood appropriate for the request for proposal", Johnson illustrates in Fig. 17.

4.   Claim 9.

"The method of claim 7, further comprising: receiving the first overlay at the second device; generating the second overlay using the first overlay; and sending the second overlay to the first device", Johnson illustrates in Fig. 18.

5.   Claim 10.

"The method of claim 9, wherein the generating the second overlay comprises: retrieving from a database the first element and the corresponding performance/prescriptive value based on the first overlay; receiving a selection for at least one second element from a second set of elements, the second element comprising a subset of the first element and in accordance with the first element's performance/prescriptive value; and storing a second representation for said second element with the first representation in electronic form", Johnson illustrates in Fig. 18.

6.   Claim 11.

"The method of claim 10, wherein the database is the first database", the database can be called any name, therefore the step is obvious.

7.   Claim 12.

"The method of claim 10, wherein the database is a second database", the database can be called

any name, therefore the step is obvious.

8.   Claim 13.

"The method of claim 10, wherein the generating the second overlay further comprises: receiving

a document function indication of proposal; and associating text segment references with text

segments that use the indicative mood appropriate for the responding proposal", Johnson

illustrates in Fig. 17.

9.   Claim 14.

"A method for developing a request for proposal and a responding proposal, comprising:

generating at a first device a first overlay representing the request for proposal, the first overlay

including references to a database for text segments associated with selected elements, the

generating including receiving an indication of document function; and associating the

appropriate grammatical mood with at least one referenced text segment based on the indicated

document function; sending the first overlay to a second device; and receiving at the first device

a second overlay from the second device, the second overlay representing the responding

proposal to the request for proposal, the second overlay comprising a modified version of the

first overlay", examiner assumes that a request for proposal (RFP) is a proposal for bids that

indicates the specifications for a particular task or other system needs (another words may be

selling services or products). Johnson teaches in Fig. 10 a block diagram a detailed depiction of

the elements in a preferred report generator, this part can be assumed as a first overlay. Johnson

teaches in Fig. 11 a block diagram showing a detailed depiction of the elements in a preferred

selection device, meaning this is the next device (second device) that provides more detailed

information to first overlay, and can be called second overlay. And also second overlay is the

modified version of first overlay. Johnson illustrates in Figs. 17-42 the connectivity of a user,

databases, and devices.

10.   Claim15.

"The method of claim 14, wherein the generating the first overlay comprises: receiving the

document function indication of request for proposal by an owner to a design-builder; and

associating text segment references with text segments that use the imperative mood appropriate

for the request for proposal by an owner to a design-builder", Johnson illustrates in Figs. 12 and

17.

11.   Claim 16.

"The method of claim 15, wherein the text segment references are associated with text segments

prefaced with language similar in mood and style to the phrase "Design and select materials to

provide..."", Johnson teaches in (cols. 5-6, lines 66-67 and 1-4) the system uses the, stored

pictures in the picture database as building blocks for filling in the template. The system

establishes a customer profile based on the customer's answers to queries. The system then uses

the profile to "build" the empty frames, such as picture 61, in template 60. But Johnson does not

explicitly specify the phrase "Design and select materials to provide...", however the phrase can

be inputted to customize data step 330 and language data step 394 Fig. 6

12.   Claim 17.

"The method of claim 14, wherein the generating the first overlay comprises: receiving the

document function indication of request for proposal by a design-builder to a sub-contractor; and

associating text segment references with text segments that use the imperative mood appropriate

for the request for proposal by a design-builder to a sub-contractor", Johnson teaches in (cols. 5-

6, lines 66-67 and 1-4) the system uses the, stored pictures in the picture database as building

blocks for filling in the template. The system establishes a customer profile based on the

customer's answers to queries. The system then uses the profile to "build" the empty frames,

such as picture 61, in template 60. But Johnson does not explicitly specify a design-builder to a

sub-contractor, however the user interface step 102 in Fig. 2 can be considered as a builder or

main/sub-contractor.

13.   Claim 18.

"The method of claim 17, wherein the text segment references are associated with text segments

prefaced with language similar in mood and style to the phrase "Provide..."", Johnson teaches in

(cols. 5-6, lines 66-67 and 1-4) the system uses the, stored pictures in the picture database as

building blocks for filling in the template. The system establishes a customer profile based on

the customer's answers to queries. The system then uses the profile to "build" the empty frames,

such as picture 61, in template 60. But Johnson does not explicitly specify the phrase

"provide...", however the phrase can be inputted to customize data step 330 and language data

step 394 Fig. 6

14.   Claim 20.

"The method of claim 19, wherein the generating the second overlay comprises: receiving a

document function indication of proposal; and associating text segment references with text

segments that use the indicative mood appropriate for the responding proposal", Johnson

illustrates in Fig. 17.

15.   Claim 21.

"The method of claim 20, wherein the proposal is by a design-builder to an owner", Johnson

does not explicitly specify a design-builder to an owner, however the user interface step 102 in

Fig. 2 can be considered as a builder or an owner.

16.   Claim 23.

"The method of claim 20, wherein the text segment references are associated with text segments

prefaced with language similar in mood and style to the phrase "Construction will provide...".

Johnson teaches in (cols. 5-6, lines 66-67 and 1-4) the system uses the, stored pictures in the

picture database as building blocks for filling in the template. The system establishes a customer

profile based on the customer's answers to queries. The system then uses the profile to "build"

the empty frames, such as picture 61, in template 60. But Johnson does not explicitly specify the

phrase "Construction will provide.", however the phrase can be inputted to customize data step

330 and language data step 394 Fig. 6

17.   Claims 6, 19, and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over

Johnson, and further in view of Oba.

18.   Claim 6.

"The method of claim 5, further comprising: retrieving from the first database a first set of data

corresponding to the first overlay and a second set of data corresponding to the second overlay;

and displaying the responding proposal based on the first and second sets of data", Johnson

illustrates in Figs. 11 and 18, but does not explicitly specify displaying the responding proposal,

however, Oba et al. teaches in (col. 4, lines 17-19) that displays the responding document

(proposal) based on the inputted contents.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was

made to incorporate the teaching of Oba into Johnson in order to display various kinds of

information occurring in course of planning can be described/changed easily in terms of the table

form and therefore, to advantage, the behavior of the system in course of planning can be

understood easily without preparing dedicated programs.

19.   Claim 19.

"The method of claim 14, further comprising: receiving the first overlay at the second device;

generating the second overlay using the first overlay, the generating including receiving an

indication of document function; and associating the appropriate grammatical mood with at least

one referenced text segment based on the indicated document function; and sending the second

overlay to the first device", Johnson does not explicitly specify the appropriate grammatical

mood, however Oba teaches in (col. 9, lines 1-55) the wording analysis and sentence structure

analysis. Thus, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to incorporate the teaching of Oba into Johnson in order to display various

kinds of information occurring in course of planning can be described/changed easily in terms of

the table form and therefore, to advantage, the behavior of the system in course of planning can

be understood easily without preparing dedicated programs.

20.   Claim 22.

"The method of claim 20, wherein the proposal is by a sub-contractor to a design-builder",

Johnson does not explicitly specify a design-builder to a sub-contractor, however the user

interface step 102 in Fig. 2 can be considered as a builder or main/sub-contractor. And also

Examiner assumes that the response from second device (sub-contractor) to the first device (a

design-builder), see rejection of claim 19.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Javid A Amini whose telephone number is 703-605-4248. The examiner

can normally be reached on 8-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Michael Razavi can be reached on 703-305-4713. The fax phone numbers for the

organization where this application or proceeding is assigned are 703-746-8705 for regular

communications and 703-746-8705 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to uthe receptionist whose telephone number is 703-306-0377.

<div align="right">

Javid A Amini
Examiner
Art Unit 2672

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Javid Amini
May 19, 2003

MICHAEL RAZAVI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600